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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,866	08/13/2001	Toru Minematsu	450100-03411	7874

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

AMINZAY, SHAIMA Q

ART UNIT PAPER NUMBER

2684

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,866

Applicant(s)

MINEMATSU, TORU

Examiner

Shaima Q. Aminzay

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The following office action is in response to Amendment, filed August 27, 2004. Claim 1 amended, claim 2 original. Claims 1 and 2 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) Patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

2. Claims 1, and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cronin U. S. Patent Number 6216016, in view of Segal et al. U. S. Patent 6167251.

Regarding claims 1 and 2, Cronin discloses a portable wireless communication apparatus (column 1, lines 16-19), and wireless communication means for wirelessly communicating with a party on the other end (see for example, column 3, lines 18-24), and call holding instruction means for instructing to hold a call upon receiving a call (see for example, column 1, lines 38-61; column 3, lines 9-

17; Abstract, lines 8-12), and control means for controlling said music information processing means when holding a call while speaking to the party on the other end according to instructions from said call holding instruction means by virtue of directing said wireless communication means so as to play back music information stored in said external memory unit and controlling said wireless communication means to transmit the music information as a call holding tone to said terminal thereon (see for example, column 1, lines 38-61; column 2, lines 64-67; column 3, lines 1-17, and lines 18-24).

However, Cronin does not disclose a memory unit connection means for connecting to an external memory unit, and music information processing means for reading out and playing back music data stored in said external memory unit being connected via the memory unit connection means.

Segal discloses memory unit connection means for connecting to an external memory unit (see for example, column 19, lines 23-33), and music information processing means for reading out and playing back music data stored in said external memory unit being connected via the memory unit connection means (see for example, column 30, lines 15-24).

It would have been obvious to one of ordinary skill in the art at the time invention was made to combine Segal's wireless phone system with voice recognition with Cronin's portable wireless communication device to provide a portable wireless telecommunications device with recording, storage, and generation of waiting messages that can be done in the portable

telecommunications device or in the radio base station, and playing music while caller is put on hold makes the wait period go faster (Cronin, column 3, lines 18-24).

Response to Arguments

3. Applicant's arguments filed August 27, 2004 have been fully considered but they are not persuasive.
4. The applicant (beginning of page 4) argued that the cited prior art (Cronin U. S. Patent Number 6216016, and Segal et al. U. S. Patent 6167251) "relates to a keyless portable cellular phone system, wherein a voice recognition system allows the user to place and receive calls. Segal distinguishes its keyless invention with conventional phones, for example in column 9, lines 43-53. Cronin, by contrast, relates to what Segal would consider a "conventional" phone. That is, Cornin relates to a portable device having radio transceiver, a keypad, and a cordless radio base station. Thus, Cornin and Segal teach away from eachother, thereby negating any motivation to combine". Examiner respectfully disagrees. As discussed in the rejected above, Cronin discloses a portable wireless communication apparatus (column 1, lines 16-19), and wireless communication means for wirelessly communicating with a party on the other end. Segal discloses memory unit connection means for connecting to an external memory unit (see for example, column 19, lines 23-33), and music

information processing means for reading out and playing back music data stored in said external memory unit being connected via the memory unit connection means (see for example, column 30, lines 15-24). Furthermore, Segal discloses while typical embodiments of the keyless portable cellular phone and system server communicate voice based signals, the embodiments can be modified to communicate other data as well (see for example, column 34, lines 54-58), and "the apparatus and techniques can be implemented for other communication devices, or any communication thereof, as desired" (column 35, lines 53-57).

Further, applicant argues (paragraph 5, page 4) "'obvious to try' is not the standard upon which an obviousness rejection should be based". Examiner respectfully points out that the "obvious to try" is not part of the office action or motivation to combine the prior art Segal and Cornin (see above).

Therefor examiner believes that It would have been obvious to one of ordinary skill in the art at the time invention was made to combine Segal's wireless phone system with voice recognition with Cronin's portable wireless communication device to provide a portable wireless telecommunications device with recording, storage, and generation of waiting messages that can be done in the portable telecommunications device or in the radio base station, and playing music while caller is put on hold makes the wait period go faster (Cronin, column 3, lines 18-24).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

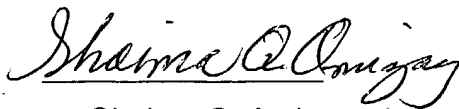
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action

Art Unit: 2684

Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaima Q. Aminzay whose telephone number is 703-305-8723. The examiner can normally be reached on 7:00 AM -5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shaima Q. Aminzay

(Examiner)


NICK CORSARO
PRIMARY EXAMINER

December 21, 2004

Nay Maung

(SPE)

Art Unit 2684